

Application No. 09/823,676
80402.0030
Atty Docket No. MBI-0034

related and share both structural similarities and functional characteristics. Figure 1 graphically shows the relatedness between sequence G1073 (SEQ ID NO: 1-2), G2789 (SEQ ID NO: 3-4), G1945 (SEQ ID NO: 5-6), and G2155 (SEQ ID NO: 7-8), all the sequences of this application. Any search based on the structure of any one of these sequences alone would, almost necessarily, encompass all the sequences of the application.

Furthermore, each of the claims corresponding to plants, methods, polynucleotides, and cells include a recitation of the same structurally and functionally similar sequences. Accordingly, a search encompassing one sequence would likely encompass all of the sequences, and a search encompassing one group of claims would likely encompass all of them. If a search for additional elements for one group of claims compared to another is needed, it would not be a burdensome search.

The claims are also related in that, for example, they encompass both methods for producing polynucleotides and plants and the plants and polynucleotides themselves. Under the PTO's Training Materials, these groups of claims should be joined and examined together. See 1184 O.G. 86, March 26, 1996. The subject matter of Groups I and III, encompassing claims 1 and 9, in particular, demonstrate the relatedness and rejoinder requirement that applies to the claims of this application.

Finally, all of the sequences claimed or recited are derived from plant transcription factors. Thus, they are several reasons why all the claims and all the sequences can be searched and examined together, notwithstanding differential classification by the PTO.

As is stated in M.P.E.P. § 803:

If the search and examination of an entire application can be made without a serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

As shown above, this application presents no such burden. Both the sequences recited in the claims and the subject matter of all the claims are related. The PTO has failed to show that a burden exists in examining all the claims together, and thus, under M.P.E.P. § 803, the claims must be examined together. Applicants respectfully request reconsideration.

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The PTO also concludes that nucleotide sequences in the specification are unrelated to one another (*see* page 4 of Paper No. 9). In this case, applicants have shown in their specification how and why the sequences are indeed related (*see* page 36, lines 20-28, for example). Applicants respectfully request reconsideration in light of this evidence.

Without considering the merits of the PTO's conclusion on the relatedness of the sequences, applicants submit that the PTO's own rules for examination indicate that a burden in examining multiple nucleotide sequences does not exist. At M.P.E.P. § 803.04, the following text appears:

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.

In some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three-dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten.

These rules clearly show and direct that at least ten different sequences can be and should be examined together. In this case, there are only four different sequences and their corresponding encoded amino acid sequences. Thus, according to the PTO, there can be no burden in searching all of the sequences of this application together. Any reasoning suggesting that restriction and election of a single sequence is proper cannot be sustained. In the face of this clear indication that at least ten sequences should be examined together, the PTO has not shown why there is a burden in searching all the claims here. None of the reasons given for the restriction requirement implicate a serious burden.

Furthermore, the PTO has not addressed or provided any evidence or reasoning on the applicability of the "exceptional case" here. As noted in the rule quoted above, certain

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complexity requirements must be met for cases where the ten nucleotide examination rule is not employed. The PTO has not asserted that this case is exceptional or provided any evidence that it might be. Thus, applicants submit that the above-quoted rule applies to this application and the PTO should apply it in this application.

No extension of time fees or requests for extension of time, or any other fees or petitions, are believed to be necessary to enter and consider this paper. If, however, any petitions or extensions of time are required or any fees are due in order to enter or consider this paper or enter or consider any paper accompanying this paper, including fees for net addition of claims, or in order to keep this application pending, applicants hereby request any extensions or petitions necessary and the Commissioner is hereby authorized to charge Deposit Account No. 50-1129 for any fees.

Respectfully submitted,

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